

CASE NO.: 50T5565.01  
Serial No.: 10/666,695  
June 17, 2006  
Page 7

PATENT  
Filed: September 19, 2003

### Remarks

Reconsideration of the above-captioned application is respectfully requested. The antecedent basis discrepancy of Claim 5 has been corrected herein.

Claims 1, 3, 9, 11, 20, 21, and 24 (of which Claims 1, 9, and 20 are independent) have been rejected under 35 U.S.C. §102 as being anticipated by Shoobridge, USPN 6,633,769, and Claims 2, 8, 10, 16, 22, and 29 have been rejected under 35 U.S.C. §103 as being unpatentable over Shoobridge in view of "official notice". Claims 4, 5, 12, 13, 25, and 26 have been rejected under 35 U.S.C. §103 as being unpatentable over Shoobridge in view of the legal doctrine enunciated in In re Japiske, while Claims 6, 7, 14, 15, 18, 19, 27, and 28 have been rejected under 35 U.S.C. §103 as being unpatentable over Shoobridge in view of Lindskog et al., USPP 2001/0031626.

The fact that Applicant has focussed its comments distinguishing the present claims from the applied references and countering certain rejections must not be construed as acquiescence in other portions of rejections not specifically addressed.

Claim 1 now incorporates the subject matter of former Claim 2; Claim 9 has been amended to incorporate subject matter from former Claim 12; non-elected Claim 17 now incorporates subject matter from former Claim 19; and Claim 20 incorporates subject matter formerly recited in Claim 21. Accordingly, the rejections of former Claims 2, 12, 19, and 21 are at issue.

To begin analysis of the rejections, Appellant notes that the Administrative Procedures Act (APA, codified in relevant part at 5 U.S.C. §706) applies to PTO conduct, Dickinson v. Zurko, 527 U.S. 150 (1999), meaning that PTO actions are set aside when they are arbitrary, capricious, an abuse of discretion,

1168-95.AMD

CASE NO.: 50T5565.01

Serial No.: 10/666,695

June 17, 2006

Page 8

PATENT

Filed: September 19, 2003

or otherwise not in accordance with the law, and that factual findings will be set aside that are unsupported by substantial evidence.

Applying the strictures implicated by Zurko to the rejections, Shoobridge is directed to a wireless access point, e.g., see the title of Shoobridge. Nevertheless, on page 2 of the Office Action, the examiner has placed on the written record a legal conclusion that a user device with wake up logic as recited in the elected claims is patentably distinct from an access point in a wireless network. Accordingly, the use of a wireless access point reference (Shoobridge) to reject the claims on page 4 of the Office Action is facially inconsistent with the contrary finding on page 2 that underpins the Restriction Requirement. Thus, two mutually exclusive legal conclusions now co-exist on the record of the case. This is perhaps the *sine qua non* of arbitrary and capricious agency action, rendering the rejection reversible.

Turning to the limitation of amended Claim 1 which had formerly been rejected on the basis of "official notice", the rejection, like the vast majority of office actions that use it, abuses the doctrine. More specifically, MPEP §2144.03 advises that the taking of official notice can be taken only of facts that "are capable of instant and unquestionable demonstration as to defy dispute", giving, as examples, adjusting flame intensity as needed for heat and tape recorders automatically erasing old data when new data is recorded onto them. Official notice of dependent claim limitations "might be appropriate" but only if the facts so noticed "are of notorious character".

Accordingly, official notice "is permissible only in some circumstances", and should be "rare" in final rejections. In any case, according to the MPEP official notice is most inappropriate of technical facts in areas of esoteric technology or of specific knowledge of the prior art. Still further, "ordinarily there must be some form of evidence in the record to support an assertion of common knowledge", and "general conclusions

1169-95.AMD

CASE NO.: 50T5565.01  
Serial No.: 10/666,695  
June 17, 2006  
Page 9

PATENT  
Filed: September 19, 2003

concerning what is basic knowledge without specific factual findings will not support an obviousness rejection."

In the present case, Claim 1 does not recite "generating an alert" in a vacuum. It requires generating an alert using a wake up signal that is otherwise used to energize a processor from a sleep mode. Using a specific wake-up signal for a purpose that has yet to be shown in the prior art is hardly the sort of fact that is "capable of instant and unquestionable demonstration as to defy dispute" that is contemplated by the doctrine of official notice.

It must be noted in addition that the question is not just whether various elements are well known, but also where the prior art supplies the motivation to combine the allegedly well-known features with the rest of the claimed elements. That is, regardless of how an element is identified in the prior art, i.e., using a reference or "official notice", the remaining task for an examiner is to show why the prior art suggests the element in the combination claimed.

For each and every taking of official notice, should the rejections be persisted in Applicant hereby requests not only a prior art showing under MPEP §2144.03 but also the requisite prior art suggestion to combine the allegedly well-known feature in the combination being rejected. Applicant explicitly traverses the taking of official notice for failing to comply with the above requirements of the MPEP.

Turning to Claim 9, which now recites limitations of former Claim 12 that had been rejected under the doctrine of In re Japiske, the relied-upon case law is unavailing because the examiner has failed to fully comprehend the legal principles involved. As MPEP §2144.04 makes clear, Japiske stands for the principle that moving the position of a starting switch on a hydraulic press did not lend patentability to a claim because moving the position of the switch would not have changed the operation of the device.

116825.AMD

CASE NO.: 50T5565.01  
Serial No.: 10/666,695  
June 17, 2006  
Page 10

PATENT  
Filed: September 19, 2003

In contrast, the present claims are not directed to a new position of a switch, much less to one on a hydraulic press, but rather to undertaking a wake-up function using a component (the physical layer of a wireless transmitter) in a fashion that the examiner admits is not taught by the reference. Furthermore, it cannot be said that moving logic to a physical layer "would not have changed the operation of the device" as required to invoke Japisky - indeed, the opposite. The presently claimed physical layer must perform new and additional logic functions and hence must *ipso facto* operate differently than Shoobridge.

Claim 17 now recites the limitation of Claim 19, which had been rejected in the context of Claims 7, 15, and 28 based on the allegation that Lindskog et al., figure 11 teaches a "code that includes a special sequence of N bytes repeated M times, wherein N and M are integers, followed by a user device identification." This is fantasy. Figure 11 is a block diagram of a MAC frame structure showing five successive blocks labeled "BCH", "FCH", "DLPHASE", "ULPHASE", and "RCH". According to the reference, paragraph 15, the RCH is a nine byte channel containing logical information. The BCH is a broadcast channel, FCH is a frame channel (paragraph 17), and DI/UL PHASE are uplink and downlink phase borders, paragraph 85.

Consequently, nothing in figure 11 of Lindskog et al. mentions anything about a code that includes a special sequence of N bytes repeated M times. Nothing in figure 11 is shown to be repeated. Moreover, nothing in figure 11 indicates that a special sequence of bytes is followed by a user device identification. Accordingly, Claim 17 is patentable.

Claim 20 now recites subject matter in Claim 21 that had formerly been rejected based on the allegation that it is found in Lindskog et al., paragraph 33. This is incorrect. The relied-upon portion of

116895.AMD

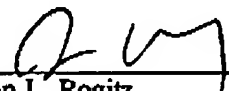
CASE NO.: 50T5565.01  
Serial No.: 10/666,695  
June 17, 2006  
Page 11

PATENT  
Filed: September 19, 2003

Lindskog et al. teaches using TIMs to transmit a list of mobile terminals, not to transmit a signal indicating that data for a device is available as recited in Claim 20.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

  
\_\_\_\_\_  
John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

JLR:jg

1168-95.AMD

BEST AVAILABLE COPY